

### REMARKS

Claims 4-13, 15-40 and 52-58 are pending. Claims 1-3, 14 and 41-51 have been canceled. Process claims 53-57 have been withdrawn from consideration as being drawn to nonelected subject matter.

New product claim 58 finds support in claims 28-30. No new matter has been added by way of the above-amendment.

### II] Election/Restriction

The Examiner has restricted the claims into the following groups.

Group I, claim(s) 4-13, 15-40 and 52 drawn to a foamed laminate.

Group II, claim(s) drawn to 53-57 drawn to a process for producing a foamed laminate.

The Examiner has taken the position that we have constructively elected by original presentation the subject matter of Group I. The Examiner believes that there is no Unity of Invention, since the cited prior art references allegedly render the instant claims unpatentable. Stated another way, the Examiner finds that there is no "special technical feature" in the present claims which amounts to a contribution over the prior art.

In response, Applicants respectfully traverse and submit that the determination of a special technical feature in the claims is an ongoing process throughout prosecution and that the special technical feature can be added by amendment. Should Applicants amend the claims to recite features that the Examiner agrees are not described in the prior art references, then these features should be considered when considering unity of invention throughout prosecution.

Furthermore, Applicants respectfully submit that new claim 58 should be included in the elected and considered Group I.

### **III Prior Art Based Issues**

Claims 4-13, 15-40 and 52 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 974 617 (EP'617) in view of EP 976 782 (EP'782). (The Examiner relies on Yorita et al. US 6,303,666 as an equivalent to EP '782). Applicants respectfully traverse the rejection.

Applicants comments regarding the patentability of the present invention over the teachings of the cited references as appearing in the July 19, 2006 Amendment are herein incorporated by reference in their entirety.

It is further submitted that new claim 58 is patentable over the cited references, which will become apparent to the Examiner upon consideration thereof.

#### **[II-A] Further comments on the patentability of claim 38:**

The Examiner is aware that Applicants have presented evidence of unexpected results, but the Examiner has raised concerns that the present claims are not commensurate in scope with the evidence of unexpected results, see the paragraph bridging pages 7-8 of the Office Action. On the contrary, Applicants respectfully submit that at least claim 38 is commensurate in scope with the unexpected results.

The Declaration filed October 31, 2005 includes a muddy slurry friction test. Since the muddy slurry test relates to the improved friction resistance, the sliding element of claim 38 would be commensurate in scope with the unexpected results. In other words, the skilled artisan would expect that there would be no change in the muddy slurry friction test by replacing the solid core of EP '617 with the foam of EP '782, since the foam core is not in contact with the sliding element. The Declaration filed October 31, 2005 clearly shows that the inventive sliding element having a foam core is superior in the muddy slurry friction test to the sliding element having a solid core. This difference would be unexpected to the skilled artisan. This is especially true when considering that EP '782 teaches that the foam has good 1) Surface Appearance, 2) Expansion Ratio, 3) Flexibility, 4) Heat Resistance, 5) Average Cell Diameter, 6) Uniformity of

Cells and 7) Stability of Quality, see page 19, beginning on line 25 of EP '782. None of these properties suggest that there would be an improvement in resistance to abrasion of a sliding element when the foam is used as a core.

As such, at a minimum, Applicants respectfully request that the Examiner indicates that claim 38 is allowable in the next communication.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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